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EXAMINER

IRSHADULLAH, M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/187,749

Applicant(s)

UTSUMI ET AL.8

Examiner

M. Irshadullah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the amendments filed September 21, 2004.

Summary Of Instant Office Action

2. Applicant's arguments regarding claims 1-10 rejected under U.S.C. 103, Office Action mailed May 21, 2004 have been fully considered and are responded below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik (US patent 5,715,404).

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Stefik discloses:

Claim 1. A license devolution apparatus (Col. 44, lines 31-61, wherein “license distribution” indicating reference’s teaching “license distribution or devolving” function and hence “a license devolution device or apparatus”), comprising:

a) storage medium accessing means for accessing a first storage medium storing contents encrypted with a predetermined key, storing a first media ID identifying the first storage medium, and storing a first encryption secure information generated by encrypting the key and a first license information that represents a right to use the contents, that represents a right to use the contents, together with one another or individually, with the first media ID, and accessing a second storage medium storing a second media ID identifying the second storage medium (Col. 7, lines 54-62, col. 9, lines 33-60 and Fig. 12 (Descriptor storage 1203 and Content storage1204 in 1207), wherein “repository 201 functioning as server receiving and processing access request and 201 functioning as requester device requesting access for digital work” indicating reference’s teaching “accessing function or means”, “repository 201 as server” representing “first storage device or medium” storing “digital work as contents file” and the contents file is “encrypted, col. 9, lines 33-37 and 58-60”, and “encrypting the contents file” indicating reference’s teaching use of “requisite known or predetermined key” as supported by: “sending repository encrypts all of its data {comprising the contents file etc.} with public writing key or receiving repository, col. 27, lines 16-24”.

Recitation: “a repository having a unique identifier, col. 13, lines 60-63” indicating reference’s teaching claimed “media ID” including the ID of above discussed server and

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in order for the server to properly communicating with other repositories or media, such as authorization repository 202 etc., col. 7, lines 62-67, the server has to have their IDs stored in it. Moreover, reference teaching "licensing functionality, col. 44, line 31 through col. 47, line 52" as indicted by: "creator licensing his digital work to distributor and distributor providing {transmitting, transferring, distributing or copying} customers, col. 44, line 32 through col. 45, line 5" and cited "access requirements, copying and transferring requirements on the distribution license" pointing to using the digital work or content according to "usage or use rights" as further described col. 9, line 20 through col. 10, line 45, Table 1, col. 10, line 57-col. 11, line 23, Figs. 10 and 14. The usage rights representing "licensing information" and a user would consider it "first" when sent to or used by the first user, such as the distributor; above discussed "encrypting all data" in "sending repository encrypting all of its data with the receiving repository key, col. 27, lines 16-19" pointing to reference's provisioning an "encryption" procedure which procedure a user would employ for encrypting cited "key(s), digital work or contents or contents file and the usage rights or first licensing information independently or individually" or "in combination or together" with media ID, such as the ID of the above discussed server, and a user using the cited "storing" function would store the forementioned encrypted information representing claimed "first encryption secure information" in the server; and above discussed repository 201 functioning as requester device representing "second repository or media" and as discussed it has an identifier or ID, which ID a user would use for accessing it employing reference's above discussed "accessing" function);

b) decoding means for decoding the first encryption secure information stored in said first storage medium using the first media ID to obtain the key and the first license information (Col. 14, lines 16-24, wherein "processing means 120 performing decryption, lines 27-28" indicating reference's teaching a "decryption or decoding" function or means, and as discussed above the first encryption secure information were encrypted with server or first media ID, the decryption function on decrypting the secure information receiving back or read the first media ID from it and then use it for retrieving or obtaining the above discussed key and the first license information); and

c) encryption means for reading the second media ID and encrypting the key and a second license information, representing a second right to use the contents devolved from the first license information stored on the first storage medium by passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium, together with one another or individually with the read second media ID, to generate a second encryption secure information with the second media ID for storage in said second storage medium (col. 27, lines 16-24 and col. 11, lines 64-67, wherein "sending repository encrypting all of its data with receiving repository key" indicating reference's teaching "encryption function or means", cited "copying, transferring, loaning" of digital work indicating reference's teaching "copying, transferring, loaning or devolving" from the above discussed repository 201 functioning as server or first media to other users' repository(ies), such above discussed repository 201 functioning as requester repository, as supported by "The next of rights attached to

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the digital work as it is transported {to other users' repository}, col. 11, lines 66-67" and further supported by col. 44, line 57 through col. 45, line 5; and user would employ the above discussed encryption means or function to "receiving or retrieving or reading" the second repository or media ID, such as that of repository 201 functioning as requester repository or media from the server (as discussed above); a user would use above discussed devolving function for devolving above discussed first license information from the server or first media to the requester repository or second media, and use the received or read second media ID for encrypting to the second repository or media above discussed devolved first licensing information using the above discussed encryption means or function. Moreover, recitation: "the copies in use value for the requested right is decremented by the number of copies involved in the transaction, col. 32, lines 37-39 and Fig. 18 {1817}" indicating reference's teaching "decrementing or degenerating" the user's original copying rights {first licensing information} as it is copying or transferring or devolving or passing down to the next or second user's {successor} repository or storage media as indicated by: "If access granted, repository 1 {server} transmitting digital work to repository 2 {requester repository}, col. 7, lines 42-44} and access, copy etc., rights are attached to digital work, col. 44, lines 57-61).

Claim 2. A license devolution apparatus according to claim 1, wherein said encryption means encrypts with the first media ID a third license information, obtained through subtracting the second license information from a first license information, or encrypts with the first media ID both the key and the third right of using, to generate a

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third secure information and stores the third encryption secure information in the first storage medium (Col. 32, lines 37-43, wherein "decrementing copies in use value by the number of copies in the transaction" indicating reference's teaching "decrementing or degenerating" and "server subtracting elapsed time" indicating reference's "subtraction" functionality, which functions a user would used for claimed purpose, and see discussion about "encryption", "first licensing information" and "media Id" above. Moreover, one would consider licensing information as first, second and third when used by first distributor, second creator and second distributor, col. 45, lines 6-14).

Claim 3. A license devolution apparatus according to claim 1, wherein if the entire rights of using the contents, to which the first storage medium is entitled, are devolved to the second storage medium (Col. 16, Table 2, level 5, lines 4-6, wherein "repository erasing or destroying digital Ids" indicating reference's teaching "erasing or destroying" function and a user would use the same for claimed purpose).

Claim 4. A license devolution apparatus according to claim 1, wherein before devolution of the right to use the contents, the first storage medium stores contents whose right to use is intended to be devolved as encrypted contents (Col. 7, lines 16-21, wherein "repository storing digital works or contents" which are or intended to be "transferred or devolved" and as discussed above, the digital works etc., are encrypted and stored in the server or first medium); and

wherein said license devolution apparatus further comprises contents transfer means for reading the encrypted contents from the first storage medium, and storing in the second storage medium the read encrypted contents (Col. 11, lines 64-65, wherein “copying, transferring, loaning” indicating reference’s teaching “transferring” function or means and the transferring means or function would retrieve or read the digital work or content in above discussed repository or server or first media and store the same in the requester repository or second media” as indicated by: “if access granted, repository 1 transmitting or transferring the digital work to repository 2 and stored therein, col. 4, lines 40-43. As discussed above, digital work or contents are encrypted).

Claim 5. A license devolution apparatus according to claim 2, wherein the first license information and the second license information represent the presence of the right to use, and the third license information represents the absence of the right to use (Col. 44, line 54 through col. 45, line 5, wherein “creator purchasing distribution license and handing it to distributor” indicating that both have licensing information and customer “lacking distribution license” indicating claimed “unavailability or absence” of the licensing information or usage or use right).

Claim 7. A license devolution apparatus according to claim 1, wherein the first and second storage media form a composite storage unit (See discussion about composite storage unit in Applicant’s claim 10 below), the composite storage unit further comprising a first drive and a second drive driving the first storage medium and the

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second storage medium, respectively, said first drive and said second drive having a first firmware and a second firmware accessing the first storage medium and the second storage medium, respectively, since the diskette or CD or other media drives have their respective drivers or softwares/firmwares for running the same),

wherein said decoding means and said encryption means are arranged in a firmware consisting of said first firmware and said second firmware in form of a composite unit (See discussion about firmware/software above and the softwares/firmwares including first and second softwares/firmwares relating to any device or means including decoding and encryption means are installed in different partitions of a memory functioning as composite unit); and

wherein only said first firmware has authority to access the first storage medium driven by said first drive, and only said second firmware has authority to access the second storage medium driven by said second drive (Inherent, since each driver {software/firmware} would {have authority} to run its respective media having an ID and access the information on it).

Claim 8. A license devolution method, comprising:

a) storing in a first storage medium contents encrypted with a predetermined key, a first media ID identifying the first storage medium, and encryption secure information generated by encrypting with the first media ID, the key and a first license information, which represents a right to use the contents (See discussion of Applicant's claim 1a) above);

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b) decoding the first encryption secure information using the first media ID to obtain the key and first use information (See discussion of Applicant's claim 1b) above);

c) generating a second encryption secure information by reading a second media ID identifying a second storage medium and encrypting with a second media ID, the key and second license information, which represents a second right to use the contents that is devolved from the first license information stored on the first storage medium by passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium (See discussion of Applicant's claim 1c) above); and

d) storing the second encryption secure information in said second storage medium, wherein the right to use the contents stored in the first storage medium is devolved from the first storage medium to the second storage medium (See Applicant's claims 1a) and 1c) above).

Claim 9. A license devolution system in communication with computer readable storages, comprising:

a) an access unit accessing a first storage unit having a first storage ID and storing contents encrypted with a predetermined key and storing a first encryption secure information generated by encrypting the key and a first license information, which represents a right to use the contents, with the first storage ID, and accessing a second storage unit having a second storage ID identifying the second storage unit

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(See the discussion of Applicant's claim 1a) above. Applicant will appreciate that reference's accessing function clearly points to the presence of "an access means or unit" in the system);

b) a decoder decoding the first encryption secure information stored in said first storage unit by reading the first storage ID and using the first storage ID to obtain the key and the first license information (See the discussion of Applicant's claim 1b) above);

c) a devolving unit devolving the right to use the contents of the first storage unit to the second storage unit by generating a second license information that represents a second right to use the contents devolved from the first license information stored on the first storage unit by passing down the first license information of the first storage medium to the second storage unit as a successor of the first storage medium and degenerating the first license information in the first storage medium (See discussion about devolving in Applicant's claim 1c) above); and

d) an encryption unit reading the second storage ID, and encrypting the key and the second use information with the read second storage ID to generate a second encryption secure information stored in said second storage unit (See discussion of Applicant's claim 1c) above).

Claim 10. A license devolution computer, comprising:

a) a composite storage unit comprising a first storage unit, a second storage unit, and a composite storage access unit accessing the first storage unit having a first storage ID and storing contents encrypted with a predetermined key and storing a first

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encryption secure information generated by encrypting the key and a first license information, which represents a right to use the contents, with the first storage ID, and accessing the second storage unit having a second storage ID identifying the second storage unit (Fig. 12 {Descriptor storage 1203, Content storage 1204 in storage system 1207} described Col. 14, lines 17-37, wherein "memory system 1207" representing "a composite storage means or unit" since cited storage 1203 and storage 1204 are different, "the storage 1203 and storage 1204 respectively are solid state storage and high speed storage like optical disk", this fact indicating that reference have to different drives for approaching or accessing the requisite storage or storage medium including first and second media having their IDs for which see discussion in Applicant's claim 1a) above);

b) a decoder decoding the first encryption secure information stored in said first storage unit by reading the first storage ID and using the first storage ID to obtain the key and the first license information (See discussion in Applicant's claim 1b) above); and

c) a devolving unit reading the second storage ID and devolving the right to use the contents of the first storage unit to the second storage unit by generating a second license information, which represents a second right to use the contents devolved from the first license information stored on the first storage unit by passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and reducing the first license information in the first storage medium according to the passing down, and encrypting the key and the

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second use information with the second storage ID to generate a second encryption secure information stored in said second storage unit (See discussion in Applicant's claim 1c) above).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik (US Patent 5,715,403) and well known feature.

In the following claim:

Claim 6. A license devolution apparatus according to claim 2, wherein the first license information represents of a first available number of times or available time, the second license information is represents a second available number of times or available time which is less than the first available number of times or available time, and the third license information represents a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time.

Stefik teaches:

document or content creator purchasing {a number of} licenses {first available number of license information} and issuing {some} of the licenses to distributors {second

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license information} and distributor distributing to any one or users {third license information}, col. 44, line 31 through col. 45, line 27.

Stefik does not explicitly teach:

second {number of} license information is less than the first and third is determined or obtained by subtracting second {number of} license information from the first {number of} license information.

However, the feature is well known and practiced in computers and mathematical arts, since the user under the agreement were obliged to use the product {document, picture or program} for a certain number of time(s) and when one user, such as the creator, would transfer/devolve the right of use to next user, such as the distributor(s), he would only do so at most the number of licenses or license informations he possesses; i.e., the second {number of} license informations must equal to or less than the first's {number of} license informations, {num of} of license informations transferring to the next {third} one is the remainder {difference of the first one's number of license informations minus number of license informations transferred/devolved to the second}, and see discussion about license information in claims 1a) and 2) above).

It would have been obvious to one of ordinary skill in the relevant art at the time of Applicant's invention to advantageously incorporate the technique or tool in vogue in Stefik's invention, thereby entailing a system enabling a user to controlling the distribution of works and keeping track of the distributed and remaining number of licenses.


Response to Arguments

7. Applicant's arguments filed September 21, 2004 have been fully considered and are moot in view of new ground of rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is 703-308-6683. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


M. Irshadullah
January 03, 2004


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